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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES R. DURKEE, DAVID CRAWFORD GIBBON,
and BEHZAD SHAHRARAY

Appeal 2009-007414
Application 09/848,581
Technology Center 2400

Before ROBERT E. NAPPI, THOMAS S. HAHN,
and ELENI MANTIS MERCADER, *Administrative Patent Judges*.

MANTIS MERCADER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the final rejection of claims 1-27. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

INVENTION

Appellants' Figure 1 is reproduced below:

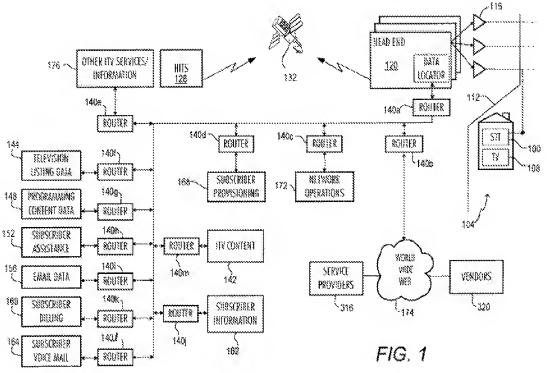

FIG. 1

Appellants' Figure 1 and claimed invention are directed to a data locator associated with a television head end 120. The remotely located data (i.e., e-mail data 156 and subscriber voice mail 164) are communicated over the same broadcasting medium on which broadcast television signals received by head end 120 are provided to the Set-Top Terminal (STT) 100. *See* Fig. 1; Spec. 7-9.

Claim 1, reproduced below, is representative of the subject matter on appeal:

1. An interactive television network, comprising:

a data locator for locating data, the data locator being in communication with a set-top terminal for accessing interactive television network components and for providing broadcast programming to a subscriber through a television connected to the set-top terminal;

one or more memories located remotely from the data locator and in communication therewith through a network and containing at least three of the following data accessible by the data locator:

television listing data containing broadcast programming scheduling information relating to past, current, and future scheduled programming on the interactive television network;

programming content data containing audio and video content of previously broadcast programming on the interactive television network;

email data containing email for interactive television network subscribers; and

interactive television network subscriber voice mail database containing voice mail information for interactive television network subscribers' telephones.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Knee	US 5,589,892	Dec. 31, 1996
Bertram	US 5,606,374	Feb. 25, 1997
Girard	US 5,751,282	May 12, 1998
Schneidewend	US 6,182,287 B1	Jan. 20, 2001
Nishikawa	US 2001/0016947 A1	Aug. 23, 2001
Ozawa	US 2001/0030959 A1	Oct. 18, 2001
Wood	US 2002/0112007 A1	Aug. 15, 2002
Vallone	US 6,642,939 B1	Nov. 4, 2003

The following rejections are before us for review:

1. The Examiner rejected claims 1-4, 8-14, and 16 under 35 U.S.C. § 103(a) as being unpatentable over Girard in view of Wood.

2. The Examiner rejected claims 5 and 6 under 35 U.S.C. § 103(a) as being unpatentable over Girard in view of Wood and further in view of Knee.

3. The Examiner rejected claims 7 and 17 under 35 U.S.C. § 103(a) as being unpatentable over Girard in view of Wood and further in view of Nishikawa.

4. The Examiner rejected claim 15 under 35 U.S.C. § 103(a) as being unpatentable over Girard in view of Wood and further in view of Vallone.

5. The Examiner rejected claim 18 under 35 U.S.C. § 103(a) as being unpatentable over Girard in view of Wood and further in view of Bertram.

6. The Examiner rejected claims 19-21 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Schneidewend in view of Bertram and further in view of Ozawa.

7. The Examiner rejected claims 22-24 under 35 U.S.C. § 103(a) as being unpatentable over Schneidewend in view of Bertram and Ozawa and further in view of Nishikawa.

8. The Examiner rejected claims 25 and 27 under 35 U.S.C. § 103(a) as being unpatentable over Schneidewend in view of Bertram and Ozawa and further in view of Knee.

ISSUES

The pivotal issues are:

1. whether Appellants have shown that the Examiner erred in finding that the combination of Girard in view of Wood teaches a data locator that provides both broadcast programming and access to the network components, as recited in representative claim 1; and

2. whether Appellants have shown that the Examiner erred in finding that Schneidewend teaches accessing services as a function of network addresses included within a broadcast stream provided by the head end.

PRINCIPLES OF LAW

The Supreme Court stated that "'[r]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.'" *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

"'The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.'" *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (quoting *KSR*, 550 U.S. at 416).

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *Kahn*, 441 F.3d at 985-86.

ANALYSIS

Analysis with respect to the rejections of claims 1-4, 8-14, and 16

Appellants argue (Br. 6-8) that there is no motivation to combine the Girard and Wood references. Appellants further argue (Br. 7-8) that, even if there is motivation to combine the references, the Examiner has not shown that the combination of Girard in view of Wood teaches a data locator that provides both broadcast programming and access to the network components.

Girard teaches that when the viewer selects a current program, the head end supplies real-time video data stream of the current program to the set-top box (col. 2, ll. 28-30). Girard further teaches that when a user selects a past program, the database at the head end provides a pointer for the location of the past program to the continuous user server which supplies the video data stream to the set-top box (col. 2, ll. 30-35). When the viewer selects a future program, the database provides the appropriate memory pointer and the continuous media server retrieves the video clip of the future program and supplies it to the set-top box (col. 2, ll. 35-39).

Girard further teaches an interactive television system having a database resident at the head end server that supplies program titles and scheduled viewing times of the past, current, and future programs to the electronic programming guide (col. 2, ll. 13-17).

Thus, clearly Girard teaches a data locator (i.e., head end with a database) in communication with a set-top box used to supply program titles and scheduled viewing times of the past, current, and future programs to the electronic programming guide, the corresponding programs stored on the head end server, and real time broadcasting (i.e., real-time video data stream

of the current program). As identified by the Examiner (Ans. 4), Girard does not teach accessing e-mail and voice mail databases. Thus, the Examiner (Ans. 4-5, 21-22) used Wood (¶ [0029]; Fig. 1) for the teaching of an integrated message management system allowing a user to retrieve via the internet messages from various email servers, voice mail systems, and messages from WebTV™. The Examiner asserted (Ans. 3), and Appellants did not contest, that it is well known in the art that WebTV™ is a source of broadcast programming and other Internet related multimedia services. The Examiner articulated as rationale to combine (Ans. 21) that, because Wood teaches that the integrated message management system includes television systems (Fig. 1, television internet connection 52 or WebTV™), one skilled in the art would expand Girard's Video on Demand (VOD) system with one that also compiles and organizes messages to provide a more centralized multimedia interface.

We agree with the Examiner that the articulated reasoning supports the legal conclusion of obviousness, because Girard's head end/database is able to locate stored information such as stored past programs, so it would be obvious to expand such capability to other stored information such as stored e-mails or voice mails to provide a more centralized multimedia interface. This is especially the case since Wood teaches (¶¶ [0029]-[0030]) that messages can be retrieved from various storage servers including television internet connections. *See KSR*, 550 U.S. at 418.

We are not persuaded by Appellants' argument (Br. 8) that the combination does not teach a data locator that provides both broadcast programming and access to the network component, and that at best, the combination would just yield separate delivery of VOD and messages

through different communication mediums. We agree with the Examiner (Ans. 22-23) that Ozawa's teaching of providing access to various remotely located multimedia devices including on demand movies (¶ [0020]), storage services, and e-mail (¶ [0022]), supports combining video systems (i.e., such as that of Girard) and database management systems (i.e., such as Woods). Appellants, who have not filed a Reply Brief, have not addressed, let alone shown any error, in the position taken by the Examiner.

We further note that Ozawa teaches a data locator (i.e., Fig. 1, head end 10) that provides, to the set-top box 20, VOD 12 but also content from remote servers 48. Thus, the combination of familiar elements (i.e., remote servers, broadcasting receivers, stored media, head end, and set-top box) as taught by Girard and Wood according to known methods, such as use of a head end to retrieve and provide data from various sources, including remote sources, to the set-top box as taught by Ozawa is obvious when it does no more than yield predictable results. *See Leapfrog*, 485 F.3d at 1161 (quoting *KSR*, 550 U.S. at 416).

Thus, we will sustain the Examiner's rejection of representative claim 1 and claims 2-4, 8-14, and 16, which fall with claim 1 as no additional arguments of patentability were presented with respect to these claims.

Analysis with respect to the rejections of claims 5-7, 15, and 17

Appellants (Br. 9) do not present any additional arguments of patentability with respect to the Examiner's rejections of claims 5-7, 15, and 17, and rather rely on their dependency from independent claims 1 or 9.

Accordingly, we will also sustain the Examiner's rejections of claims 5-7, 15, and 17.

Analysis with respect to the rejections of claims 18-27

Appellants argue (Br. 10), that patentable weight should be given to the preamble limitation of a data structure providing a network address as recited in claim 18. We agree that patentable weight is given to the preamble limitation since the claimed "the network address" refers back to the preamble limitation wherein "a network address" was introduced. Since the Examiner (Ans. 12-13) did not give weight to the preamble, we will reverse the Examiner's rejection of claim 18.

Appellants argue (Br. 11-12), with respect to claims 18[1] and 19, that Schneidewend does not teach accessing services as a function of network addresses included within a broadcast stream provided by the head end.

We are persuaded by Appellants' arguments. We agree with the Examiner (Ans. 14) that Schneidewend provides network addresses associated with remote systems (col. 2, ll. 17-31; col. 5, l. 67–col. 6, l. 3; Figs. 3-4) overlaid over an ongoing video program (Fig. 3). However, we do not find support in the reference for the *head end unit* (i.e., data locator) providing broadcast programming *including network addresses*. If anything, it appears that the user pre-selects these "favorite" network addresses, and thus, they would not have been transmitted by the head end unit providing broadcast programming.

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[1] We note that claim 18 was not rejected using the additional reference of Schneidewend, but only potentially referenced by the Examiner (Ans. 13) as rejected under the same rationale of Schneidewend if patentable weight was to be given to the preamble's limitation of "the broadcast programming includes a data structure providing a network address." Regardless, Appellants addressed Schneidewend with respect to claim 18.

Accordingly we will reverse the Examiner's rejections of claims 18-20 and 26 as well as the rejections of dependent claims 21-25, and 27 which were not separately argued (Br. 13). The additional cited references do not cure the above cited deficiency.

CONCLUSIONS

1. Appellants have not shown that the Examiner erred in finding that the combination of Girard in view of Wood teaches a data locator that provides both broadcast programming and access to the network components.

2. Appellants have shown that the Examiner erred in finding that Schneidewend teaches accessing services as a function of network addresses included within a broadcast stream provided by the head end.

ORDER

The decision of the Examiner to reject claims 1-17 is affirmed. The decision of the Examiner to reject claims 18-27 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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